

BROOKHAVEN SCIENCE ASSOCIATES

BROOKHAVEN NATIONAL LABORATORY

AGREEMENT FOR USE OF THE ACCELERATOR TEST FACILITY (ATF) –

A DOE DESIGNATED USER FACILITY

This Agreement is entered into by BROOKHAVEN SCIENCE ASSOCIATES, (“BSA”), which operates Brookhaven National Laboratory (“Brookhaven”), Upton, New York, 11973, under contract with the United States Government as represented by the U.S. Department of Energy (“DOE”), and _____ (“User”).

1. BSA certifies that the User, if an individual, or representatives of the User, if an institution, have been selected to conduct research at the Accelerator Test Facility (“ATF”). During all activities of the User under this Agreement, representatives of the User shall continue to be, or for the purposes of this Agreement shall be considered to be, employees of the User, an independent contractor.

2. BSA and the User both recognize that this Agreement is written pursuant to the DOE “Class Waiver of Patent Rights to Inventions Made By Users of DOE User Facilities” issued by DOE in March of 1983.

3. The Patent and Technical Data Provisions which form a part of this Agreement and which pertain to work done under this Agreement are set forth in Attachment A hereto.

4. The User and its representatives recognize that execution of this Agreement is a pre-condition to access to the ATF.

5. The User and its representatives agree to comply with all Brookhaven policies, procedures, and guidelines applicable to guests at Brookhaven, including the procedures and guidelines set issued for use of the ATF.

6. The User and its representatives agree that in exchange for the opportunity to conduct research at the ATF as a guest scientist at Brookhaven, they will publish the results of their research when such results are appropriate for publication in the scientific literature.

7. The User and its representatives agree to treat proprietary data or other technical, business or financial data in the form of recorded information, which they receive or to which they are given access pursuant to association with the ATF under this Agreement, in accordance with any restrictive legend contained thereon, unless use in excess of the restrictive legend is specifically authorized in writing by DOE.

8. The User and its representatives agree to notify the ATF Project Head Department at Brookhaven if it intends to conduct any proprietary research at the ATF so that the appropriate ATF Proprietary Users Agreement can be executed.

9. This Agreement shall become effective when signed by the parties hereto and shall continue as long as representatives from User are conducting research at the ATF, unless sooner terminated upon written notice by either party.

The User shall obtain agreements to effectuate the foregoing provisions and those set forth in Attachment A from all its employees or other persons who perform on User's behalf any part of the work under this Agreement.

USER:

BROOKHAVEN SCIENCE ASSOCIATES

By:

By:

(Signature)

(Signature)

Name of User:

Name: Lori-Anne Neiger

Title of User:

Title: Interim Manager, Office of
Intellectual Property & Sponsored
Research

Date:

Date: _____

Mailing Address of Institution:

ATTACHMENT A

INTELLECTUAL PROPERTY PROVISIONS

1. PATENT RIGHTS

(a) Definitions

- (1) “User” means the person or entity with which this agreement is made.
- (2) “Subject Invention” means any invention or discovery of the User, conceived or first actually reduced to practice in the course of or under this agreement, and includes any are, method, process, machine, manufacture, design, or composition of matter, or any new an useful improvement thereof, or any variety of plants, whether patented or unpatented under the Patent Laws of the United States of American or any foreign country.
- (3) “Facility Operator” means the operating contractor which manages and operates the Government-owned, contractor-operated facility where the work under this agreement is to be performed.
- (4) “Patent Counsel” means the DOE Patent Counsel assisting the Facility Operator.

(b) Rights of the User

(1) Election to retain rights

Subject to the provision of paragraph (a)(2) of this clause, the User may retain the entire right, title and interest in any patent application filed in any country on a Subject Invention reported an elected in accordance with paragraph (d) of this clause in any resulting patent secured by the User. Where appropriate, the filing of patent applications by the User is subject to DOE security regulations and requirements.

(2) Minimum License

The User reserves an irrevocable, nonexclusive, paid-up license in each patent application filed in any country on Subject Invention and any resulting patent in which the User does not elect to retain title or in which the Government acquires title. The license shall extend to the User’s domestic subsidiaries and affiliates, if any, within the corporate structure of which the User is a part and shall

include the right to grant sublicenses of the same scope to the extent the User was legally obligated to do so at the time this agreement was entered into. The license shall be transferable only with approval of DOE except when transferred to the successor of that part of the User's business to which the invention pertains.

(c) Rights of Government

(1) Assignment to the Government

The User agrees to assign to the Government, upon request, the entire right, title, and interest in any country to each Subject Invention of the User except to the extent that rights are retained by the User under Paragraph (b)(2) of this clause, where the User:

- (i) Does not elect pursuant to this clause to retain such rights; or
- (ii) Fails to have a patent application filed in that country on the Subject Invention or decides not to continue prosecution or not to pay any maintenance fees covering the invention; or
- (iii) At any time, the User no longer desires to retain title.

(2) Terms and Condition of Waived Rights

- (i) To preserve the Government's residual rights to Subject Inventions, the User shall take all actions in reporting, electing, filing on, prosecuting and maintaining invention rights promptly, but in any event, in sufficient time to satisfy domestic and foreign statutory and regulatory time requirements, or, if the User decides not to take appropriate steps to protect the invention rights, it shall notify DOE in sufficient time to permit the Government to file, prosecute and maintain patent applications and any resulting patents prior to the end of such domestic or foreign statutory or regulatory time requirements.
- (ii) The user shall convey or assure the conveyance of any executed instruments necessary to vest in the Government the rights set forth in this clause.
- (iii) With respect to any Subject Invention in which the User retains title, the Government shall have a nonexclusive, a nontransferable, irrevocable, paid-up license to practice or

have practiced for or on behalf of the United States the Subject Invention throughout the world.

- (iv) The User shall provide the Government a copy of any application filed on a Subject Invention promptly after such application is filed, including its serial number and filing date.
- (v) The User agrees to submit on request periodic reports no more frequently than annually on the utilization of Subject Invention or on efforts at obtaining such utilization that are being made by the User or its licensees or assignees. Such report shall include information regarding the status of development, date of first commercial sale or use, gross royalties received by the User, and such other data and information as DOE may reasonably specify. The User also agrees to provide additional reports as may be requested by DOE in connection with any march-in proceeding undertaken by DOE in accordance with paragraph (c)(2)(vii) of this clause. To the extent data or information supplied under this paragraph is considered by the User, its licensee or assignee to be privileged and confidential and is so marked, DOE agrees that, to the extent permitted by 35 USC 202(c) (5), it will not disclose such information to persons outside the Government.
- (vi) Notwithstanding any other provision of this clause, the User agrees that neither it nor any assignee will grant to any person the exclusive right to use or sell any Subject Invention in the United States unless such person agrees that any products embodying the Subject Invention or produced through the use of the Subject Invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by DOE upon a showing by the User or its assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.
- (vii) The User agrees that with respect to any Subject Invention in which it has acquired title, DOE has the right in accordance with the procedures in 37 CFR 401.6 and any supplemental regulations of DOE to require the User, an assignee or exclusive licensee of a Subject Invention to

grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants upon terms that are reasonable under the circumstances, and if the User, assignee, or exclusive licensee refuses such a request, DOE has the right to grant such a license itself if DOE determines that:

- (1) Such action is necessary because the User or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the Subject Invention in such field of use.
- (2) Such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the User, assignee, or their licensees;
- (3) Such action is necessary to meet requirements for public use specified by federal regulations and such requirements are not reasonably satisfied by the User, assignee or licensee; or
- (4) Such action is necessary because the agreement required by paragraph (a)(2)(vi) of this clause has not been obtained or waived or because a licensee of the exclusive right to use or sell any Subject Invention in the United States is in breach of such agreement.

(d) Invention Identification, disclosure, and reports

- (1) The User shall furnish the Patent Counsel a written report containing full and complete technical information concerning each Subject Invention of the User within 6 months after conception or first actual reduction to practice, whichever occurs first, in the course of or under this contract, but in any event prior to any on sale, public use or public disclosure of such invention known to the User. The report shall identify the agreement and inventor and shall be sufficiently complete in technical detail and appropriately illustrated by sketch or diagram to convey to one skilled in the art to which the invention pertains a clear understanding of the nature, purpose, operation, and to the extent known, the physical, chemical, biological, or electrical characteristics of the invention. The report should also include any election of patent rights under this clause. When an invention is reported under this paragraph (d), it shall be presumed to have been made in the manner specified in Section (a)(1) and (2) of 42 U.S.C. 5908.

(e) Limitation of rights

Nothing contained in this patent rights clause shall be deemed to give the Government any rights with respect to any invention other than a Subject Invention except as set forth in the Facilities License of paragraph (f).

(f) Facilities License

In addition to the rights of the parties with respect to inventions or discoveries conceived or first actually reduced to practice in the course of or under this agreement, the User agrees to and does hereby grant to the Government an irrevocable, non-exclusive paid-up license in and to any inventions or discoveries regardless of when conceived or actually reduced to practice or acquired by the User, which at any time through completion of this contract are owned or controlled by the User and are incorporated in the facility as a result of this agreement to such an extent that the facility is not restored to the condition existing prior to the agreement (1) to practice or to have practiced by or for the government at the facility, and (2) to transfer such license with the transfer of that facility. The acceptance or exercise by the Government of the aforesaid rights and license shall not prevent the Government at anytime from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed.

2. NOTICE AND ASSISTANCE REGARDING PATENT AND COPYRIGHT INFRINGEMENT

- (a) The User shall report to the Government, promptly and in reasonable written detail, each notice or claim of patent or claim of patent or copyright infringement based on the performance of this agreement of which the User has knowledge.
- (b) In the event of any claim or suit against the Government on account of any alleged patent or copyright infringement arising out of the performance of this agreement or out of the use of any supplies furnished or work or services performed hereunder, the User shall furnish to the Government when requested by the Government, all evidence and information in possession of the User pertaining to such suit or claim. Such evidence and information shall be furnished at the expense of the Government except where the User has agreed to indemnify the Government.

3. RIGHTS IN TECHNICAL DATA

(a) Definitions

The definitions set forth in 41 CFR 9-9.201 apply to the extent those terms are used herein.

(b) Allocation of Rights

(1) The government shall have:

- (i) Unlimited rights in technical data first produced or specifically used in the performance of this agreement.
- (ii) The right to have any technical data first produced or specifically used in the performance of this agreement delivered to the Government as the Government may from time to time direct during the progress of the work or upon completion or termination of this agreement.

(2) The User shall have:

The right to use for its private purposes, subject to patent, security or other provisions of this agreement, technical data first produced in the performance of this agreement provided the data requirements of this agreement have been met as of the date of the private use of such data. The User agrees that to the extent it receives or is given access to proprietary data or other technical, business or financial data in the form of recorded information from DOE or a DOE contractor or subcontractor, the User shall treat such data in accordance with any restrictive legend contained thereon, unless use is specifically authorized by prior written approval of the Government.

(c) Copyrighted Material

(1) The User agrees to, and does hereby grant to the Government, and to its officers, agents, servants and employees acting within the scope of their duties:

- (i) A royalty-free, nonexclusive, irrevocable license to reproduce, translate, publish, use and dispose of and to authorize others so to do, all copyrightable material first produced or composed in the performance of this agreement by the User, its employees or any individual or concern specifically employed or assigned to originate and prepare such material; and

- (ii) A license as aforesaid under any and all copyrighted or copyrightable works not first produced or composed by the User in the performance of this agreement, but which are incorporated in the material furnished under the agreement, provided that such license shall be only to the extent the User now has, or prior to completion or final settlement of the agreement may acquire, the right to grant such license without becoming liable to pay compensation to others solely because of such grant.
- (2) The User Agrees that it will not knowingly include any material copyrighted by others in any written or copyrightable material furnished or delivered under this agreement without a license as provided for in subparagraph (1)(ii) hereof, or without consent of the copyright owner, unless it obtains specific written approval of the Government for the inclusion of such copyrighted material.